

REMARKS

At the outset, Applicants wish to express appreciation for the Examiner's indication that claim 7 contains allowable subject matter. By the above amendments and the following remarks, it is respectfully submitted that all claims are in form for allowance.

Summary of Office Action

Claims 1-5 and 11 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Japanese Patent No: JP-06247569A to *Ohashi*.

Claims 6 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of Japanese Patent No: JP-403079519A to *Ishihara*.

Claim 10 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ohashi* in view of Japanese Patent No: JP-2000122362A to *Ishio et al.* ("*Ishio*").

Claim 7 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the features of the base claim and any intervening claims.

Summary of Response to the Office Action

By this Amendment, Applicants amend the specification, title, drawings, and claims 1 and 11. Claim 18 is added for an alternative scope of protection. Accordingly, claims 1-7, 10-12, and 18 remain pending for consideration.

Objection to the Title

The title was objected to for not being descriptive of the invention. Applicants propose submitting a new title as suggested in the Office Action, as shown above. Accordingly, Applicants respectfully request withdrawal of the objection to the title.

Drawings

To overcome the Office Action's objection of the drawings, Applicants concurrently file a Submission of Formal Drawings with one (1) sheet of formal drawings to substitute the original filed drawing sheets. The new formal drawings amend Fig. 22 to include the label "Related Art." Applicants respectfully request that the objection to the drawings be removed.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-5 and 11 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Ohashi*. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action has not established that *Ohashi* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites "[a]n image forming apparatus . . . is horizontally movable in any of two directions relative to a main body of the image forming apparatus," and newly amended independent 11 recites the feature of "[a]n image forming apparatus . . . wherein . . . the sheet tray is movable in any of two directions substantially orthogonal to each other." At least these features are not disclosed or taught by *Ohashi*.

Ohashi discloses an imaging apparatus that provides "paper sheets from the direction of copying by a user doing a copy work from the back, that is paper discharge side by drawing out an outer frame so as to simultaneously draw out an outer frame tray and an inner frame tray, or drawing out only an inner frame tray against the device main body." The Office Action suggests that a singular sheet tray 1050 moves in two directions orthogonal to each other. Contrary to this assertion, *Ohashi* discloses two separate trays: an outer tray 1061 and inner tray 1062 that move

orthogonally to each other. See Fig. 3 of *Ohashi*. *Ohashi* actually teaches away from the present invention by disclosing two trays. Because *Ohashi* does not disclose the singular tray feature, it cannot anticipate the invention recited in claims 1 and 11.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Ohashi* does not teach or suggest each feature of independent claims 1 and 11.

Additionally, Applicants respectfully submit that dependent claims 2-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ohashi* in view of *Ishihara*. This rejection is respectfully traversed.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined,

must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, neither *Ohashi* nor *Ishihara*, either alone or in combination teaches or suggests at least the feature of "[a]n image forming apparatus . . . is horizontally movable in any of two directions relative to a main body of the image forming apparatus," as recited in claim 1, and the feature of "[a]n image forming apparatus . . . wherein . . . the sheet tray is movable in any of two directions substantially orthogonal to each other," as recited in claim 11, from which claims 6 and 12 depend, respectively. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claims 6 and 12.

The Office Action fails to meet at least one of the three requirements for establishing a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being -unpatentable over *Ohashi* in view of *Ishio*. This rejection is respectfully traversed.

Applicants respectfully submit neither *Ohashi* nor *Ishio*, either alone or in combination teaches or suggests at least the feature of "[a]n image forming apparatus . . . is horizontally movable in any of two directions relative to a main body of the image forming apparatus," as recited in claim 1, from which claim 10 depends. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claim 10.

Ishio does not make up for deficiencies previously demonstrated in *Ohashi*. Accordingly, it is respectfully submitted that the rejection is in error. Withdrawal of the rejection under 35 U.S.C. § 103(a) over *Ohashi* in view of *Ishio* is respectfully requested. Claim 10 is also allowable at least because it recites the same combination of features as independent claim 1, as well as the additional features it recites that further distinguish them over the applied art.

For the same reasons above-mentioned, it is respectfully submitted that none of the references of record teach or suggest the features of Applicants pending claims. In view of the above arguments, Applicants respectfully request that the rejection of claim 10 under 35 U.S.C. §103(a) be withdrawn.

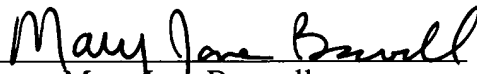
CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the application and timely allowance of pending claims. The Examiner is invited to contact the undersigned by telephone if any issues remain unresolved.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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IN THE DRAWINGS:

To overcome the Office Action's objection of the drawings, Applicants concurrently file herewith a Submission of Replacement Drawings with one (1) sheet of replacement drawings to substitute for the original filed drawing sheets. Fig. 22 (sheet 21) is amended to be labeled as "Related Art." Support for the new label can be found at least at page 1, line 19 through page 2, line 10 of the Applicants' specification as originally filed. No new matter has been added. Applicants respectfully request that the objection to the drawings be removed.